

<b>Advisory Action</b>	<b>Application No.</b> 09/744,016	<b>Applicant(s)</b> VOELKEL, HELGE	
	<b>Examiner</b> Sheridan L. Swope	<b>Art Unit</b> 1652	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Applicants claims now recite a more narrow invention not previously claimed.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: 23.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

## Claim Rejections - 35 USC § 112-First Paragraph

Rejection of Claims 1-22 under 35 U.S.C. 112, first paragraph is maintained. Applicants argument that the inventive subject matter is concerned with a method for screening for activity of only one Calcineurin/SOD combination at a time and that a discussion about variants is irrelevant to the claimed invention is not found to be persuasive. Claims 1-22 continue to claim a method using any combination of any calcineurin and any SOD. A person of ordinary skill in the art would not be able to use the recited invention without undue experimentation. Furthermore, said methods are not sufficient described by the specification. Therefore, rejection of Claims 1-22 under 35 U.S.C. 112, first paragraph is maintained.

## Claim Rejections - 35 USC § 102

Rejection of Claims 1-5, 9, 13- 16, 18, 19, and 21, under 35 U.S.C. 102(b) as being anticipated by Wang et al, 1996 is maintained. Applicants attempt to overcome said rejection by amendment of Claim 1 to recite a method for screening for a modulator that affects a direct interaction between a calcineurin and a SOD raises new issues that would require further consideration and additional searching. Therefore, this amendment is not entered and rejection of Claims 1-5, 9, 13- 16, 18, 19, and 21, under 35 U.S.C. 102(b) is maintained.

## Claim Rejections - 35 USC § 103

Rejection of Claims 6-8 and 17 under 35 U.S.C. 103(a) as being unpatentable over Wang et al, 1996 in view of Brown et al, 1997, rejection of Claim 9 under 35 U.S.C. 103(a) as being unpatentable over Wang et al, 1996 in view of Woodrow et al, 1993, rejection of Claims 10-12 over Wang et al, 1996 in view of Lau et al, 1996 or Robbins et al, 1993 and further in view of Aramburu et al, 1998, and rejection of Claims 5, 15, and 17 under 35 U.S.C. 103(a) as being unpatentable over Wang et al, 1996 in view of admission of availability (Specification page 28 lines 21-24) are maintained. Applicants argument that as presently amended, the inventive method is directed only to the monitoring of complex formation and not to enzymatic activity is not found to be persuasive. Applicants attempt to overcome said rejections by amendment of Claim 1 to recite a method for screening for a modulator that affects a direct interaction between a calcineurin and a SOD raises new issues that would require further consideration and additional searching of the dependent Claims, 6-8 and 17. Therefore, this amendment is not entered and rejection of Claims 6-8 and 17 under 35 U.S.C. 103(a) is maintained.

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